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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,994	02/17/2004	Lawrence A. Schwartz	3582 P 003	8889
<div>7590      08/27/2007</div> <div>Monique A. Morneault, Esq. Wallenstein Wagner &amp; Rockey, Ltd. 311 South Wacker Drive, 53rd Floor Chicago, IL 60606-6630</div>				
			EXAMINER THORNEWELL, KIMBERLY A	
			ART UNIT 2128	PAPER NUMBER
			MAIL DATE 08/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10779994	2/17/04	SCHWARTZ, LAWRENCE A.	3582 P 003

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**EXAMINER**

Kamini S. Shah

**ART UNIT****PAPER**

2128

20070822

**DATE MAILED:**

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

As per your telephonic request, attached is a copy of missing NPL document by Gravesen. Since this defect or error was brought to the attention to the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected.

Kamini S Shah

SPE

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/779,994	SCHWARTZ, LAWRENCE A.	
	Examiner	Art Unit	
	Kimberly Thornewell	2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                           |

### **DETAILED ACTION**

1. Claims 1-13 were originally presented for examination. In the reply dated 5/18/2007, Applicants amended claims 4 and 7 and cancelled claims 10 and 12-13. Therefore claims 1-9 and 11 remain pending in the instant application.

### ***Response to Arguments***

#### **Claim Objections**

2. Applicant amended claim 4 to recite a method for assessing a building's propensity to foster mold growth according to the system of claim 1. However, this amendment does not overcome the objection to claims 4-6 because these dependent claims do not further limit the system of claim 1. Therefore the objection to the claims is maintained.

#### **Claim Rejections, 35 USC § 112**

3. Applicant amended claim 4 to recite a method for assessing a building's propensity to foster mold growth according to the system of claim 1. However, this amendment does not overcome the rejection of claims 4-6 under 35 USC § 112, second paragraph. It is unclear whether Applicant intends claim 4 to be a dependent claim or an independent claim. If dependent, it does not contain structural limitations that further limit the system of claim 1. If independent, it is in improper format because it makes reference to claim 1. Therefore, the rejection of claim 4-6 under 35 USC § 112, second paragraph is maintained.

#### **Claim Rejections, 35 USC § 101**

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4. Applicant is thanked for amending claim 7 to overcome the rejection under 35 USC § 101. Accordingly, the rejection is withdrawn.

*Claim Rejections, 35 USC § 103*

5. Applicant's arguments, see pages 5-8, filed 5/18/2007, with respect to the rejection(s) of claim(s) 1-13 under 35 USC § 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly discovered prior art references.

*Claim Objections*

6. Claims 4-6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 recites a method "for the system of claim 1," comprising steps for assessing a building's propensity to foster mold growth. Claims 5 and 6 depend on claim 4 and further modify the claimed method. Because claim 1 is directed to a structure, patentable weight is not given to functional limitations. Consequently, because claims 4-6 are directed only to functional limitations to the system of claim 1, the claims fail to further limit the system.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As noted in the Claim Objections above, claims 4-6 fail to further limit parent claim 1 in that the claims only contain functional limitations. Because the claims do not further limit the system of claim 1, it is unclear as to what the Applicant is regarding as his invention. Furthermore, it is unclear whether Applicant intends claim 4 to be a dependent claim or an independent claim. If dependent, it does not contain structural limitations that further limit the system of claim 1. If independent, it is in improper format because it makes reference to claim 1.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skidmore et al., US PreGrant Pub 2003/0040934, in view of Gravesen et al., "Microfungal Contamination of Damp Buildings- Examples of Risk Constructions and Risk Materials," Environmental Health Perspectives Volume 107, Supplement 3, June 1999.

As per claim 1,

Skidmore discloses a system for assessing a building's propensity to mold growth (paragraph 19 lines 3-5), the system comprising:

- A base module (**figure 1 server 26**);
- A remote module being communicably connected to the base module (**figure 1 inspector terminal 12 and PDA 14**);
- An inspection form accessible to the base and remote modules (**paragraph 17 lines 25-29, paragraph 18 lines 1-2**), the inspection form including a plurality of building characteristics utilized during inspection of the building (**paragraph 20 lines 11-20**); and,
- A calculator being operably connected to the base module and capable of utilizing the inspection form (**paragraph 23 last 3 lines**).

Skidmore does not disclose expressly the calculator determining a mold risk score.

Gravesen discloses assessing a building's propensity to mold growth by determining a mold risk score (**page 1 last paragraph, *score system using an index describing the different conditions for collected materials in a building***). It would have been obvious to one of ordinary skill in the art of building assessment, at the time of the present invention to modify Skidmore's home warranty system with Gravesen's teachings of providing a mold risk score in order to calculate a home warranty based on its risk for mold infestation. The motivation for doing so would have been to allow customization by tailoring the home inspection system for specifically mold inspection (Skidmore paragraph 5 last 3 lines, paragraph 19).

As per claim 2,

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Skidmore discloses the building characteristic being selected from the group consisting of interior (page 4 column 1 lines 25-28), exterior (page 3 paragraph 20 line 20-page 4 column 1 line 1), roofing (page 4 column 1 lines 1-3), building envelope (page 3 paragraph 20 line 20-page 4 column 1 line 1), attic (page 4 column 1 lines 3-9), foundation drainage (page 4 column 1 lines 8-12), plumbing (page 4 column 1 lines 23-25), foundation type (page 4 column 1 lines 8-12), and HVAC system (page 4 column 1 lines 19-23).

As per claim 4,

Skidmore discloses for the system of claim 1, a method for assessing a building's propensity to foster mold growth, the method comprising the steps of:

- Providing the inspection form (paragraph 17 lines 8-17);
- Receiving a completed inspection form (paragraph 18 lines 1-2); and
- Calculating a score in response to the completed inspection form (paragraph 23 last 3 lines).

Gravesen discloses the score being a mold risk score (page 1 last paragraph, *score system using an index describing the different conditions for collected materials in a building*).

As per claim 5,

Gravesen discloses performing a mold growth propensity assessment in response to the calculated mold risk score (page 2, Results paragraph 2 beginning "*The susceptibility to fungal infestation...*").



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11. Claims 3, 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skidmore in view of Gravesen as applied to claims 1-2 and 4-5 above, and further in view of NAHB Research Center, "Mold in Residential Buildings," Toolbase Technotes July 24, 2001.

As per claims 3 and 6,

Skidmore discloses an action item list providing suggestive solutions being generated from the inspection form (**paragraph 18**, *for example, allowing a homeowner to repair damaged items in order to provide tailored warranty coverage*).

Neither Skidmore nor Gravesen disclose expressly the action item list including solutions to reduce the mold risk score. NAHB discloses a list of suggestive solutions to reduce the mold risk score (**bulleted list page 3**).

It would have been obvious to one of ordinary skill in the art of building assessment, at the time of the present invention, to modify Skidmore's suggestive solutions in an action item list to include NAHB's suggestive solutions to reduce the mold growth risk. It would have further been obvious to generate the action item list in response to Gravesen's the calculated mold risk score exceeding a predetermined level. The motivation for doing so would have been to alleviate concern about mold in buildings (NAHB page 1).

As per claim 7,

Skidmore discloses a method for evaluating mold growth probability within a structure comprising the steps of:

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- Providing questions over a network regarding the structure and building materials used therein (**paragraph 17 lines 8-17**);
- Receiving answers over the network to the questions (**paragraph 18 lines 1-2**); and
- Performing a calculation in response to the answers (**paragraph 23 last 3 lines**):

Skidmore does not disclose expressly the calculation being a mold risk score. Gravesen discloses assessing a building's propensity to mold growth by determining a mold risk score (**page 1 last paragraph, *score system using an index describing the different conditions for collected materials in a building***). It would have been obvious to one of ordinary skill in the art of building assessment, at the time of the present invention to modify Skidmore's home warranty system with Gravesen's teachings of providing a mold risk score in order to calculate a home warranty based on its risk for mold infestation. The motivation for doing so would have been to allow customization by tailoring the home inspection system for specifically mold inspection (Skidmore paragraph 5 last 3 lines, paragraph 19).

Neither Skidmore nor Gravesen disclose expressly the action item list including solutions to reduce the mold risk score. NAHB discloses a list of suggestive solutions to reduce the mold risk score (**bulleted list page 3**).

It would have been obvious to one of ordinary skill in the art of building assessment, at the time of the present invention, to modify Skidmore's suggestive solutions in an action item list to include NAHB's suggestive solutions to reduce the mold growth risk. It would have further been obvious to generate the action item list in response to Gravesen's the calculated mold risk

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score exceeding a predetermined level. The motivation for doing so would have been to alleviate concern about mold in buildings (NAHB page 1).

As per claim 8,

Skidmore discloses providing the calculation over the network (**paragraph 23 last 3 lines**). Modified with Gravesen as in claim 7 above, it would have been obvious to provide the mold risk score over the network.

As per claim 9,

Gravesen discloses performing a mold growth propensity assessment in response to the calculated mold risk score (**page 2, Results paragraph 2 beginning "The susceptibility to fungal infestation..."**).

As per claim 11,

Skidmore discloses receiving results of a thermal image of the structure and including the results of the thermal image as a variable in performing the calculation (**paragraph 20 last 6 lines**). Modified with Gravesen as in claim 7 above, it would have been obvious for the calculation to be the mold risk score.

### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Thornewell whose telephone number is (571)272-6543. The examiner can normally be reached on 9am-5:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571)272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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